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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,776	07/21/2003	Hiroyuki Hagano	26D-010	4241
23400	7590	07/18/2006	EXAMINER	
POSZ LAW GROUP, PLC 12040 SOUTH LAKES DRIVE SUITE 101 RESTON, VA 20191			VIJAYAKUMAR, KALLAMBELLA M	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/622,776

Applicant(s)

HAGANO ET AL.

Examiner

Kallambella Vijayakumar

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 17-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Art Unit: 1751

DETAILED ACTION

- Applicant's amendment filed 04/18/2006 overcomes the rejection in the last office action.
- Claims 1-16 were cancelled and new claims 17-22 were added which are currently pending with the application.
- Applicant's arguments with respect to claims have been fully considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The use of phrase "for grounding" in the claim-17 has not been treated with patentability. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

1. Claims 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimotsuma et al (US 5,262,470).

Shimotsuma et al teach a laser inscribed molded article comprising: (i). A thermoplastic polyester such as polybutylene terephthalate/PBT, (ii). 0.01-2% by wt carbon black with a particle size of 0.1 micron <100 nm>-150 microns, and (iii). 0-70% by wt steel fibers. The prior art further teaches laser inscribing of

Art Unit: 1751

the article using a CO2 laser (C-7, Ln 11-27; C-2, Ln 21-32; C-6, Ln 34-59; Fig-1). The electrical conductivity of the polyester compound molded article will be inherent, because, the prior art composition is identical to that by the applicants, and identical compositions have identical properties. All the limitations of the instant claims are met.

The reference is anticipatory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
-
1. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimotsuma et al (US 5,262,470) in view of Hara et al (US 5,275,776).

The disclosure on the composition and molded article by Shimotsuma et al (US 5,262,470) as set forth in rejection-1 under 35 USC 102(b) is herein incorporated.

The prior art is silent about the type of steel fibers used in the molding compositions.

In the analogous art of molded thermoplastic compositions, Hara et al teach reinforcing polyester moldings with stainless steel fibers (C-1, Ln, 64-67; C-4, Ln 43-47; C-5, Ln 14-20).

Art Unit: 1751

It would be obvious to a person of ordinary skill in the art to combine the prior art teachings to substitute the steel fibers of Shimotsuma et al with stainless steel fibers of Hara et al as functional equivalents with reasonable expectation of success because the teachings are in the analogous art of molded articles.

2. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimotsuma et al (US 5,262,470) in view of Springholtz et al (DE 10013000).

The disclosure on the composition and molded article by Shimotsuma et al (US 5,262,470) as set forth in rejection-1 under 35 USC 102(b) is herein incorporated.

The prior arts fail to teach forming a cap cover using the compositions.

In the analogous art of molded objects, Springholtz et al teach forming automobile parts including tank caps from conductive compositions containing thermoplastic polymer filled with conductive carbon black/carbon fiber/metal-filaments (US Pub: 2003/0021926 as English Translation of DE 10013000: Para-0001-0002, 0004, 0010, 0012).

It would be obvious to a person of ordinary skill in the art to combine the prior art teachings to form automobile parts including tank caps from the Shimotsuma et al with reasonable expectation of success, because the combined prior art teaching is suggestive of claimed tank cap, and the teachings are in the analogous art of molded articles.

Response to Arguments

Applicant's arguments filed 4/18/2006 have been fully considered. Applicant's argue that the prior art by Shimotsuma et al fails to disclose that the inorganic fillers gives the non-conductive material conductive properties is not persuasive (Response, Pg-7, Para-4), because addition of conductive fillers such as metallic fillers in dielectric polymers forming conductive compositions is well known in the art (See Liu et al (EP 185783), Pg-3, Ln 1-2, 15-20; Pg-4, Ln 15). Applicants further argue to treat "for grounding" to be treated with patentability is not persuasive, because it is an intended use and not an essential limitation of the claim (Pg-7, Para-7).

Art Unit: 1751

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kallambella Vijayakumar whose telephone number is 571-272-1324. The examiner can normally be reached on 8.30-6.00 Mon-Thu, 8.30-5.00 Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571-272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KMV
June 28, 2006.


Mark Kopec
Primary Examiner